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EXAMINER

BEFUMO, JENNA LEIGH

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/747,529
Filing Date: December 22, 2000
Appellant(s): SHEPPARD, JAMES M.

MAILED
JUN 28 2007
GROUP 1700

Gregory N. Clements
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 3, 2006 with a supplemental Summary of Claims filed on November 22, 2006 and a copy of the Evidence Appendix and Related Appeals Appendix filed in the original Appeal Brief on May 15, 2006 appealing from the Office action mailed February 24, 2006.

(1) Real Party in Interest

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A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

The current application has been previously reviewed by the board, with a decision submitted on July 29, 2004.

09/837,094 is a continuation in part of this application and is currently being appealed by the applicant.

10/314,794 was appealed by the applicant on April 1, 2006, but the examiner has reopened prosecution in this case and it is not currently being appealed.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter, submitted on November 22, 2006, has been substituted for the original summary contained in the brief. The amended summary is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

NEW GROUND(S) OF REJECTION

Claims 21, 22, 24 – 27, 29, 30, 32 – 34, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terrasse in view of Stark.

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Claims 21, 22, 24 – 30, and 32 – 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. and Stark, as set forth above, and in further view of Terrasse.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

Additionally, it is noted that the evidence appendix which includes copies of the declarations filed by the applicant are included in the Appeal Brief filed on May 15, 2006.

(8) Evidence Relied Upon

1,925,459	Parker et al.	3-1931
3,669,818	Stark	6-1970
3,721,273	Sherrill et al.	3-1973
2,163,769	Terrasse	5-1937

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

I. Claims 21, 22, 24 – 30, and 32 – 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stark in view of Parker et al.

Stark discloses a pile fabric having a patterned surface and a design superimposed on the patterned surface for use in carpets, towels, and upholstery (abstract). Further, Stark discloses that there is a continuing desire in the textile field to produce new and aesthetically pleasing textile products (column 1, lines 25 – 29). *Various patterns* may be produced in the textile fabric itself by *varying the construction* of the pile surface and *using different color yarns to create various parts or sections* of the fabrics (column 1, lines 29 – 31 and 40 – 45). Further, Stark discloses that it is known in the art to print patterned pile fabrics *in registry* with sections of the existing pattern (column 1, lines 45 – 47). Or, the printed design can be can be printed on the woven pile fabric out of registry with the weave pattern producing a particularly attractive fabric for use in carpets, towels, and the like (column 1, lines 50 – 58).

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The pile fabric can be produced by conventional means, including weaving, to produce *a desired pattern* in the fabric (column 2, lines 13 – 15). The printing can be applied by various methods including roller printing, screen printing, photographic printing or the like (column 2, lines 22 – 25). And the printed design can include *multiple colors onto fabrics made from different colored yarns* (column 2, lines 23 – 28). Additionally, the pile yarns can be looped yarns or cut yarns (column 2, lines 29 – 30). When the looped yarns are cut, the process inherently releases tension in the yarn and allows the fibers to spread open to some degree. Finally, Stark discloses that the particular pile pattern used to make the fabric is *virtually unlimited*, as is the print design to be applied to the fabric, and the final product is *governed by the desired visual appearance* (column 2, lines 43 – 47).

Thus, Stark discloses a multi-colored, patterned woven fabric to which a printed design is applied. Further, Stark discloses that the weave pattern and yarn colors can be chosen from an unlimited number of designs based on the desired visual appearance of the end product. Also, the patterned, woven fabric can be printed with various colors and patterns, by known printed methods, to enhance the aesthetics of the product. And the printing can be done in or out of registry with the pattern woven in the fabric.

While Stark discloses fabrics made with different color yarns, Stark fails to teach patterned pile fabrics having a woven two-color design on a first side and the reverse design on the opposite side. Parker et al. is drawn to pile fabrics comprising a woven pattern produced by using contrasting yarns (lines 1 – 5). Parker et al. discloses that the patterned fabric is made up of two different color pile yarns using a first color yarn to form the background of the design and a second color to form the image of the design on the first side of the fabric, while the second side of the fabric is the reverse with the first color forming the image and the second color forming the background (lines 15 – 25). The different colored yarns can be used to form stripes or other designs (lines 13 – 15). Since two different colored yarns are used to make the woven fabrics, then one of the colored yarns will inherently be a lighter color than the

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other colored yarn. Also, the filling yarns can be different colors creating cross borders, or transverse stripes, in the fabric, with the opposite side being a reverse image (lines 28 – 35).

Thus, Parker teaches a woven patterned fabric which includes two different colored yarns which are woven to form a patterned design on the first side and an inversely colored design on the opposite side. Further, Parker et al. teaches that the pattern can be woven to have contrasting colored cross borders.

Thus, it would have been obvious to one having ordinary skill in the art to use a patterned, woven fabric having a first image on the first side and a reverse image on the second side, with border regions, as disclosed by Parker et al. as the patterned woven fabric in the printed pile fabric disclosed by Stark since Stark discloses that a printed design can be combined with various patterned pile fabrics of any construction to produce a visually appealing finished product. Thus, the combination of Parker et al. and Stark produces a woven fabric, with a reverse image pattern woven into the fabric and a printed design placed on the fabric in or out of registry with the woven pattern of the fabric.

The applicant is claiming a woven fabric comprising a first and a second colored yarn regions. The fabric is woven such that the wherever the first colored yarn appears on the front side of the fabric, the second color appears on the back side of the fabric, and wherever the second color appears on the front side of the fabric, the first color appears on the backside, producing a patterned fabric with an inversely colored backside. This type of woven structure, a two colored patterned fabric wherein the different colors are woven to create an inverse pattern, is given patentable weight and is expressly taught by Parker et al. While Parker et al. teaches patterns which include stripes and cross borders, Parker et al. does not explicitly teach that the fabric produces a pattern with a central region and a border. However, it has been held that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Further, it has been held that where the printed matter is not functionally

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related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983). Thus, the limitations with regards to the locations of the different colored regions and printed matter, i.e., the border and central area, relate purely to ornamentation and do not effect the function of the fabric itself. Therefore, the limitations that the first colored regions form a border and the second colored regions form a central area are not given patentable weight since they relate to the appearance and ornamentation of the fabric and do not provide a mechanical function. The functional limitations of the colored pattern are due to the fact that different colored regions are woven so that the contrasting, second colored regions are next to and on the opposite side of the fabric from the first colored regions. As shown above, the weave design is taught by Parker et al.

Alternatively, since Parker et al. and Stark both suggest that various known weave pattern and print patterns can be used to produce a finished printed fabric, it would have been obvious to one having ordinary skill in the to choose woven pattern with borders regions and an open central area for designs to provide a large central area to place the printed pattern and create an aesthetically pleasing appearance in the finished fabric.

Further, it is noted that the applicant's limitations that the fabric is produced on a jacquard loom is an apparatus limitation which is not given patentable weight in the product claim. The patentability of the product is based on the structural limitations of that product and not how it is made or what machine is used to make it. Thus, if the claimed product can be made on a different apparatus or by a different process, the claim is unpatentable even though the prior product was made by a different process or apparatus.

Additionally, claims 21 and 29 recite that the border is capable of masking the graphic impression that may overlap in the border area. However, the claimed product does not positively require that the

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graphic impression overlaps with the border. Thus, the prior art only needs to be able to mask a printing color. Additionally, the limitation reciting that the central area on the back of the woven fabric is capable of masking any potential bleed through only requires that the contrasting color regions would be able to mask the print. The contrasting color regions adjacent and on the opposite side of the fabric would inherently be capable of masking printing which is a similar color. Thus, claims 21, 22, 24 – 30, and 32 – 36 are rejected.

II. Claims 21, 22, 24 – 30, and 32 – 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. in view of Stark.

The features of Parker et al. and Stark have been set forth above. Parker teaches a woven patterned fabric which includes two different colored yarns which are woven to form a patterned design on the first side and an inversely colored design on the opposite side. Further, Parker et al. teaches that the pattern can be woven to have contrasting color borders. Parker et al. fails to teach adding a printed design to the patterned, pile fabric. As set forth above, Stark discloses that it is known in the art to add printed designs, in or out of registry with the woven pattern, to pile fabric to produce finished products which are aesthetically attractive to the consumer. Hence, it would have been obvious to one having ordinary skill in the art to add a printed design as disclosed by Stark to the patterned fabric taught by Parker et al. because fabric taught by Parker et al. can be enriched by applying a printed pattern to the fabric which enhances the desirability of the end product (Stark, column 2, lines 48 – 50).

While Stark and Parker do not teach specific design patterns, i.e., the specific features of a towel having borders at each edge and a central area where the printing is applied, both Stark and Parker acknowledge that various woven and printed designs are known and can be combined together to form any desired visual appearance. As set forth above, the limitations drawn to the fabric being woven to create different colored regions wherein the regions have a first color on one side and a second color on the opposite side, so that when the fabric is flipped over it has the inverse image on the opposite side are

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given weight. Parker et al. teaches weaving fabrics to produce this appearance wherein the colors are limited to regions and the opposite side of the fabric is woven with a contrasting color.

However, as set forth above, the claimed border and central area design is created by organizing the different colored regions in particular areas, and not by changing the overall weave structure of the towel or by adding additional components to the towel. As set forth in § MPEP 1502.01 a “utility patent” protects the way an article is used and works, while a “design patent” protects the way an article looks (35 U.S.C. 171). The ornamental appearance for an article includes its shape, configuration, and/or surface ornamentation applied to the article. It has been held that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Further, it has been held that where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983). Thus, the border and central area, as well as the striped regions and contrasting colored cross borders taught by Parker et al., are ornamental design features which can be readily interchanged without modifying the mechanical function of the fabric.

In the alternative, since Parker et al. and Stark both suggest that various known weave pattern and print patterns can be used to produce a finished printed fabric, it would have been obvious to one having ordinary skill in the to choose woven pattern with borders regions and an open central area for designs to provide a large central area to place the printed pattern.

Further, it is noted that the applicant’s limitations that the fabric is produced on a jacquard loom is an apparatus limitation which is not given patentable weight in the product claim. The patentability of the product is based on the structural limitations of that product and not how it is made or what machine is used to make it. Thus, if the claimed product can be made on a different apparatus or by a different

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process, the claim is unpatentable even though the prior product was made by a different process or apparatus.

Additionally, claims 21 and 29 recite that the border is capable of masking the graphic impression that may overlap in the border area. However, the claimed product does not positively require that the graphic impression overlaps with the border. Thus, the prior art only needs to be able to mask a printing color. Additionally, the limitation reciting that the central area on the back of the woven fabric is capable of masking any potential bleed through only requires that the contrasting color regions would be able to mask the print. The contrasting color regions adjacent and on the opposite side of the fabric would inherently be capable of masking printing which is a similar color. A striped towel will have darker regions adjacent to lighter regions and a darker colored region on the opposite side as the lighter region, which when printed on will have regions that would mask the printing and bleed through.

Therefore, the claimed features which deserve patentable weight are, the woven towel having two different color yarns which create a first pattern on the a first side and an inverse pattern on the reverse side, with a graphic impression printed on one side. And as set forth above, these features are taught by Stark and Parker et al. And with respect to choosing different towel designs and combining printed designs with woven designs, Stark discloses combining weave designs with printed designs to create various towel products and further teaches it is known to apply the printed design in or out of registry with the pattern of the towel. Additionally, Parker et al discloses that different color yarns can be used to produce different color sections in the towel with a reverse image on the opposite side of the towel. Further, the prior art references also disclose that the patterns which can be used to produce the towel design are virtually unlimited. Thus, the prior art teaches applying print to multi-color patterned towels based on the woven pattern of the towel and that patterned towels with a first image on one side and a reverse image on the opposite side are known. Thus, claims 21, 22, 24 – 30, and 32 – 36 are rejected.

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III. Claims 21, 22, 24 – 30, and 32 – 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stark and Parker et al., as set forth above, and in further view of Sherrill et al.

The features of Stark and Parker et al. have been set forth above. As set forth above, the exact design of the colored regions and location of the printed image have not been given patentable weight. In the alternative, Sherrill et al. is included in the rejection as evidence that the design claimed by applicant, a border region surrounding a center area with a design or graphic, is known to those in the art.

Sherrill et al. is drawn to printed terry cloth towel products. As shown in Figure 1, the towel is produced with the border design on all four edges and a image in the central area created by the border. Thus, Sherrill et al. discloses that the design pattern desired by the applicant, i.e., a border design on all four edges of the towel and image in the center portion of the towel, is known to those in the art.

Therefore, it would have been obvious to one of ordinary skill in the art to create towels with a known design structure, as shown in Sherrill et al., by combining woven patterns with printed patterns as taught in Stark and Parker et al., which teaches creating towels with different colored sections combined with printed patterns to produce a desired finished product. Also, this would create a towel that is visually and texturally appealing due to the printed images, colors, and weave structure. Thus, claims 21, 22, 24 – 30, and 32 – 36 are rejected.

IV. Claims 21, 22, 24 – 27, 29, 30, 32 – 34, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terrasse in view of Stark.

Terrasse discloses a woven fabric of a reversible pattern of large surface composed of two different colors (column 1, lines 1 – 5). As shown in Figures 1 and 2, the woven fabric has a first face A with a light colored central portion and dark colored, striped border regions on all four edges of the towel and a second face B which has the reversed pattern with a dark colored central regions and a light colored, striped border regions. Terrasse discloses that the light colored yarn is white and the dark color yarn is blue (column 2, lines 45 – 55). Further, Terrasse discloses that the border regions or bands of color can

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be made any desired length and width so that all types of borders may be formed by using two different colored yarns to produce various combinations (column 4, lines 1 – 13). Terrasse suggests that it would be desired to provide decorations or embellishments to the central area of the fabric (column 4, lines 10 – 13). However, Terrasse fails to teach printing the central region of the fabric.

As set forth above, Stark discloses that it is known in the art to add printed designs, in or out of registry with the woven pattern, to patterned, woven fabrics to produce finished products which are aesthetically attractive to the consumer. Further, Stark teaches that various printing methods including screen printing can be used to print onto the woven fabric. Hence, it would have been obvious to one having ordinary skill in the art to add a printed design as disclosed by Stark to the patterned fabric taught by Terrasse since Stark teaches that woven patterned fabrics can be enriched by applying a printed pattern to the fabric which enhances the desirability of the end product (Stark, column 2, lines 48 – 50).

Further, both dark and light colors would inherently be able to mask dark or light printing colors, respectively, which might overlap onto the border regions, or bleed through onto the back of the fabric. Thus, claims 21, 22, 24 – 27, 29, 30, 32 – 34, and 36 are rejected.

V. Claims 21, 22, 24 – 30, and 32 – 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. and Stark, as set forth above, and in further view of Terrasse.

The features of Parker et al. and Stark have been set forth above. As set forth above, the exact design of the border regions and central regions have not been given patentable weight. Alternatively, Terrasse, as set forth above, discloses a woven fabric with a reversible image made from two different colored yarns having a central section of a first color on one side and striped border regions with a second color on a first side of the fabric, and a central section of the second color and a striped border regions with the first color on a second side of the fabric. Thus, it would have been obvious to one having ordinary skill in the art to use the known weave design of Terrasse as the weave pattern in the woven pattern in the fabric taught by Parker et al. since Parker et al. discloses that the woven fabric can comprise two contrasting

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colored yarns and include border regions (column 1, lines 9 – 30). Thus, claims 21, 22, 24 – 30, and 32 – 36 are rejected.

(10) Response to Argument

I. The applicant argues that the combination of Stark, Parker et al., and Sherrill fails to specifically teach a woven fabric with a first colored border region and a second colored central region on one side and a second central region colored the first color with a border region colored the second color on the second side (Appeal Brief, pages 9 – 11). However, Parker et al. teaches a woven fabric wherein the fabric has two contrasting colored yarns which forms reverse patterns on the front and back of the woven fabric. Parker et al. discloses that the fabric can be woven to form stripes as well as cross borders produced by the contrasting color (column 1, lines 9 – 33). Thus, Parker et al. teaches a woven pattern with two contrasting colors that form a reverse pattern and can have border regions with contrasting colors. However, Parker et al. does not explicitly teach the design has a central region and borders on all four sides of the central regions. Stark discloses that various woven patterns can be used to make the printed woven fabrics. Thus, it would have been obvious to one of ordinary skill in the art to use known patterns and fabric designs which are aesthetically pleasing. Further, Sherrill et al. discloses that the central printed area with a border region design is known in the art. In fact, even the applicant admits in their own disclosure that jacquard weaving designs which employ two colors in the lineal band of the warp yarns are known (specification, page 2, 3rd paragraph). Therefore it would have been obvious to one having ordinary skill in the art to choose any desired weave design that is known in the art to produce the woven pile fabric of Parker et al.

Further, it is noted that the specific weave design with certain colored yarns located in certain region of the fabric relates to the ornamentation of the fabric itself. The location of the different colored yarns, i.e., a striped fabric versus a central area with a border, would not structurally change the weave structure itself, but just the appearance of the woven fabric. The yarns are interlaced in the same pattern

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regardless of whether the yarn is a dark color yarn or a light colored yarn, used to produce reverse stripe designs, or reverse central regions with borders designs. Thus, the physical structure of the woven fabric is the same regardless of where the different colored yarns are located. Further, as demonstrated by Stark, it is obvious to choose different weaving patterns to create the woven fabric and the number of designs which can be used to create woven fabric is virtually unlimited. Also, it has been held that where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983). As set forth above, the border and central region design, versus different colored stripe designs, is ornamental and does not effect the mechanical function of the fabric.

Additionally, the applicant argues that the design can be printed in the light colored central area while the dark colored regions can mask any print which overlaps onto the border or masking any bleed through on the back of the fabric (Appeal Brief, page 11 – 12). First, it is noted that the applicant does not positively claim that the print has overlapped onto the borders. Thus, the claim only requires that the fabric is *capable* of masking the print. Since a dark colored region would mask dark print, but not white or light print, the dark border would inherently be capable of masking some print. Further, the light colored regions would also mask print colors that are about the same color as the border regions. Thus, any color region is capable of masking some prints, and no one border color would completely mask all print colors, and would mask the print regardless of whether the fabric is woven with a stripe pattern or a central region and border pattern.

With regards to claim 29, the applicant argues that the prior art fails to teach the border regions surrounding the central area, wherein the backside has the reverse colored pattern (Appeal Brief, page 12). However, as set forth above, the border and central area design is a design feature relating to

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ornamentation only, and matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Also, the applicant argues that the prior art doesn't teach that the fabric has the ability to mask the print overlap or bleed through (Appeal Brief, pages 12 – 13). Again, as set forth above, this masking ability would be inherent to any patterned fabric with different color regions regardless of whether or not the fabric is woven to create a border and central region design or a striped design.

Further, the applicant argues that the specific location of the dark and light colored regions give the design weight over simple ornamentation (Appeal Brief, pages 12 – 13). However, the applicant is not positively claiming that the printed pattern overlaps or bleeds through. Thus, the applicant is claiming a woven fabric, which is woven in a desired design and printed in a desired pattern. Printing woven fabrics is well known as shown by the prior art. Additionally, all colors would inherently have some ability to mask certain colors. Further, it is well known that dark colors would mask most printing designs, which is why white or other white colors are printed on dark colors. Thus, when using a woven fabric made with contrasting colors, it would have been obvious to one having ordinary skill in the art to print dark colored design on the lighter colored woven regions or light colored designs on the dark colored woven regions. As is shown by the prior art it is not novel to use contrasting colors in the two colored woven fabric (Parker et al.), and one would naturally apply a printed design to colored region where it have the most contrast to the background color.

II. The applicant argues that the examiner improperly ignored limitations in the claimed by considering them as design choices or giving them no patentable weight (Appeal Brief, page 15). As set forth above, the claim does not specifically claim that the print has overlapped or bled through the fabric. Thus, the limitations do not positively require the border regions to be printed and mask the color. Further, white borders would inherently mask white print, while black borders would inherently mask

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dark colors, but not white or bright print colors. Thus, any border color is inherently capable of masking certain print colors. Also, the limitation was not given limited weight because it is functional language, but because it recites that the border is *capable* of masking print, and does not positively recite it is masking color. It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Further, the applicant argues that design features of the contrasting colors of the border regions and the central regions should be given patentable weight. As set forth above, the fact that woven fabric was made formed with patterned regions having contrasting colors was given patentable weight. Specifically, Parker et al. teaches that the reversed patterned fabric has a first color appear on the first side of the fabric and a second contrasting color is located on the back side of the fabric. And further, where the second color is located on the first side, the first color is located on the second side. Therefore, Parker et al. teaches that the fabric is a two colored pattern fabric wherein each region has a first color on one side and a contrasting second color on the opposite side, to create a reverse pattern. Additionally, since the colors are described as contrasting colors, one of the colors would inherently be darker and the other color would be lighter when compared to each other, thus, the fabric is made from a dark color and a light color.

Parker et al., teaches a reverse patterned woven fabric. With regards to the woven fabric's patterned design, it is only the specific location of the different colored regions, i.e., a border region and a central area, which Parker et al. fails to teach. And it is the specific location of these regions, and not the different colored regions, that is considered to be a design limitation that does not effect the functionality of the woven, printed fabric. A two-colored striped fabric wherein the contrasting colors produce a reversed color pattern would also have the ability to mask certain colors which overlap into the contrasting color regions or bleed through. This function is not unique to the border and central area

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pattern and the border and central area pattern is not required for the fabric to have a masking ability.

Therefore, the specific border and the central region design relates to ornamentation only and has no mechanical function. Design matters which relate purely to ornamentation only cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Thus, the specific location of the colored regions, i.e., the borders and central regions, verse inversed colored stripes, is not sufficient to distinguish the present invention from the prior art. Thus, the rejection is maintained.

III. With regards to the rejections based on Parker et al. in view of Stark, the applicant refers to the arguments of Stark in view of Parker al. (Appeal Brief, Page 19 – 20). As set forth above, the applicant's arguments of Stark and Parker et al. are not sufficient to overcome the rejection. Therefore, the rejection is maintained.

IV. Finally, the Applicant has argued that the claims are allowable due the commercial success as evidenced by the Affidavits submitted on November 21, 2002, and April 21, 2003 (Appeal Brief, pages 20 – 22). The applicant argues that the Examiner has not offered any specific reasons why the declarations are not sufficient to show commercial success or that the evidence lacks a nexus between the claimed invention and the evidence of commercial success. The declarations did not provide sufficient support to show commercial success, because there was nothing to show that the reason for the increase of sales and the increased profit of these towels is due to the nature of the claimed product, i.e., the fact that the applicant applied a printed image to two-tone towel, and not due to other factors such as the marketing of the towel, a lower price to make the towel, a higher mark-up in price than the other products, or production decisions to not produce more expensive products. The declarations do not mention any specifics with regards to these other factors which would influence the sales. Also, the exact structure of the towels which are referred to as the Edge Hand towel, the Edge Pro towel, and the Edge Beach towel have not been defined by the applicant. Thus, it is unclear if the products which produced sales figures

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presented by the applicant have the same scope as the claimed product. The evidence of commercial success must be commensurate in scope with the claims (see §MPEP 716.03 (a) I). Further, commercial success must be directly derived from the claimed invention and not the result of heavy promotion or advertising, consumption by purchasers normally tied to an applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. *In re Mageli* 470 F.2d 1380, 176 USPQ 305 (CCPA 1973). Thus, while evidence shows that sales increased for the claimed product, the evidence is not sufficient to clearly establish that the increase sales are due to the claimed features and not due to other external forces which unduly influenced the sales increase.

Further, the Applicant could not provide information which would show the market share of the claimed towel, or even show how the towel did as compared to similar products. Thus, the sales information provided *only* represents the claimed towel as compared to the Applicant's other products. Finally, it has been held that gross sales figures do not show commercial success absent evidence as to the market share. *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015 226 USPQ 881 (Fed. Cir. 1985). Thus, this is not sufficient evidence without the evidence as to the market share of the towel. Merely showing that there was commercial success of an article which embodied the invention is not sufficient. *Ex parte Remark*, 15 USPQ2d 1498, 1502-02 (Bd. Pat. App. & Inter. 1990). Could the sales be a result of outside companies removing products from the market or going out of business? Are the sales a result of the Applicant's own plans to push this one product to the exclusion of their other products? Finally, is the amount of revenue generated by the claimed towel due to the product's mark-up price and not a direct indicator of the products successfulness? How did the price of the towels influence their sales versus the other towels. Sales figures are not just solely due to the product by itself, but the market as a whole, marketing of the product, pricing of the product and supply of the product. The evidence provided by the applicant fails to address any of these questions. Therefore, the evidence provided by the Applicant does not provide a good perspective of how the product has done in the market as a whole or compared to

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similar products sold by competitors, or how the sales are influenced by their own production and marketing plans. Therefore, one cannot reasonably tell what the increased sales of the presently claimed product are a result of.

Further, the applicant specifically describes using image dying to produce the printed image. However, the independent claims and the claims which further limit the printing process are not limited to only image dying. Hence, the product discussed in the affidavit is not commensurate in scope with the current claims. Also the applicant discusses that the image is applied to a sheared surface to produce enhanced clarity and resolution in the printed image. The independent claim does not require a sheared surface or address the resolution of the image. Finally, the applicant states that the printed image can be overprinted on the center portion because the dark border prevents the printing from being seen. However, neither the overprinting or the limitation that the border is a darker color than the center area which is printed is recited in the independent claim. Thus, the affidavits are not commensurate in scope to the claimed product and cannot be used to show nonobviousness of the claimed product.

Additionally, the Applicant provided statements from competitors which stated these other companies would not sell a similar product while the present patent application was pending (Appeal Brief, pages 22 – 23). While these statements provide evidence that the towel is a desired product, these statements also reflect the competitors desire to avoid an infringement law suit if the pending application were to be given a patent. These statements do not actually provide evidence of the novelty of the present claims. Therefore, these statements are not sufficient evidence to establish commercial success or long felt need.

With respect to the applicant's evidence of copying, more than the mere fact of copying is necessary to make that action significant because copying may be attributable to other factors (see §MPEP 716.06). Alleged copying is not persuasive of nonobviousness when the other manufacturer had

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not expended great effort to develop its own solution. *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985).

Further, with regard to the declaration showing long felt need (Appeal Brief, page 22 – 24), the applicant relies on the commercial success of the product. However, as set forth above the commercial success has not been shown to be a result of selling the claim towel as opposed marketing, pricing, or production of the products which had a stronger influence on the sales of the towels. Establishing long-felt need *requires* objective evidence that an art recognized problem existed in the art for a long period of time without solution (see §MPEP 716.04). The applicant provided no evidence to show this was in fact a problem than was recognized in the art or that others had been trying to solve the same problem unsuccessfully. The evidence that the towel was copied by others does not show that they were trying to solve an art recognized problem or that the problem existed for an extended period of time. Thus, the declarations are not sufficient to overcome the art rejections.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided in the Appeal Brief submitted on May 15, 2006. Further, the Appendix of the Appeal Brief also includes copies of the declarations of commercial success and long felt need.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any

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amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.


(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

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Respectfully submitted,

Jenna-Leigh Befumo


JENNA BEFUMO
PRIMARY EXAMINER

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:


GREGORY MILLS
QUALITY ASSURANCE SPECIALIST

Conferees:

Jennifer Michener


JENNIFER MICHENER
QUALITY ASSURANCE SPECIALIST


Terrel Morris